

## PATENT COOPERATION TREATY

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REC'D 17 OCT 2005



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## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 47/64439WO	<b>FOR FURTHER ACTION</b>		See Form PCT/IPEA/416
International application No. PCT/GB2004/003211	International filing date (day/month/year) 23.07.2004	Priority date (day/month/year) 24.07.2003	
International Patent Classification (IPC) or national classification and IPC B29D11/00, B65B5/04			
Applicant PROVIS LIMITED et al.			
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 8 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> sent to the applicant and to the International Bureau) a total of sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>			
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input checked="" type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input checked="" type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input checked="" type="checkbox"/> Box No. VIII Certain observations on the international application</p>			
Date of submission of the demand  24.05.2005		Date of completion of this report  18.10.2005	
Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016		Authorized Officer  Roberts, P  Telephone No. +31 70 340-2305 	



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**Box No. I Basis of the report**

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- 1: With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
  - ☐ publication of the international application (under Rule 12.4)
  - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements\*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

**Description, Pages**

1-25 as originally filed

**Claims, Numbers**

1-64 as originally filed

**Drawings, Sheets**

1/5-5/5 as originally filed

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):

\* If item 4 applies, some or all of these sheets may be marked "superseded."



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**Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application,

☒ claims Nos. 1-35,49-64

because:

☒ the said international application, or the said claims Nos. 1-23,49-56,58-64 relate to the following subject matter which does not require an international preliminary examination (specify):

**see separate sheet**

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☒ no international search report has been established for the said claims Nos. 24-35,53,54,57

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form ☐ has not been furnished

☐ does not comply with the standard

the computer readable form ☐ has not been furnished

☐ does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.

☐ See separate sheet for further details



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**Box No. IV Lack of unity of invention**

1. ☒ In response to the invitation to restrict or pay additional fees, the applicant has:
- ☒ restricted the claims.
  - ☐ paid additional fees.
  - ☐ paid additional fees under protest.
  - ☐ neither restricted nor paid additional fees.
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is
- ☐ complied with.
  - ☒ not complied with for the following reasons:  
**see separate sheet**
4. Consequently, this report has been established in respect of the following parts of the international application:
- ☐ all parts.
  - ☒ the parts relating to claims Nos. 36-48 .

**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	36-48
Inventive step (IS)	Yes: Claims	
	No: Claims	36-48
Industrial applicability (IA)	Yes: Claims	36-48
	No: Claims	

2. Citations and explanations (Rule 70.7):

**see separate sheet**



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**Box No. VIII Certain observations on the international application**

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The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

**see separate sheet**



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**Re Item III and IV**

As indicated in the letter of 13 Sept 2005 the applicant wished examination for only claims 36-48.

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement**

Reference is made to the following document/s/:

- D1: US-A-6 143 210 (ANGE JEFFREY ET AL) 7 November 2000 (2000-11-07)
- D2: WO 98/57788 A (BAUSCH & LOMB) 23 December 1998 (1998-12-23)
- D3: US-B1-6 558 584 (STEVENSON THOMAS ET AL) 6 May 2003 (2003-05-06)
- D4: WO 03/039969 A (HAMILTON RONALD S ; PROVIS LTD (GB)) 15 May 2003 (2003-05-15)
- D5: US-A-6 029 808 (RENKEMA KORNELIS ET AL) 29 February 2000 (2000-02-29)
- D6: US-A-5 515 964 (BAUMAN ROBERT C) 14 May 1996 (1996-05-14)

**Novelty**

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 36 is not new in the sense of Article 33(2) PCT.

Document D4 ( see page 2) discloses (the references in parenthesis applying to this document):

feature B of the application( ( D) the ratio of the internal radius of the packed cavity to the lens back optical zone radius is less than 1.2, and preferably less than 1.1)

feature C of the application ( ( E) the maximum internal height of the cavity is less than 6



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mm)

feature D of the application ( (F) disclosing that the clearance is less than 2.5 mm also discloses that the clearance is less than 2.0 or 1.7 mm.)

feature E of the application ( (G) the ratio of cavity sagittal height to lens sagittal height is less than 1.6)

Similar arguments apply to D5 (see col. 2 lines 8-10) and D6 ( col.3 lines 36-42 and fig. 5 which discloses the advantage of this invention namely being able to recover a contact lens without the fingernail coming into the fluid).

Inventive Step

Further even if it could be argued that certain combination were not known then these claims would not involve an inventive step.

D1 teaches that the known features above enable low material cost ( see page 2 line 22) which is also a problem mentioned in the application ( page 25 line 26). Therefore a skilled man would be directed towards one of the problems to be solve by the application, and some known features; hence extrapolation and interpolation of these known features to solve a known problem would be routine.

Similarly the extrapolation of the feature of D4:

( B) the radius of curvature in the internal surface of the cavity is less than 10 mm, ( Feature A)

which is only just outside the values in the claim would in a similar fashion be a matter of routine experimentation and extrapolation. Hence all possible combinations of claim 36 are anticipated.

Similar arguments apply to D5 and D6 and especially D6 which discloses a container



which enables a contact lens to be recovered without a fingernail contacting the fluid in the container ( see application page 23 line 27).

**Dependent Claims**

Dependent claims 37-48 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step. Especially D4 discloses features F and G of claim 37- see features H and I on page 2 of D4.

**Re Item VIII**

Claim 36 comprises features H to L inclusive whilst the description on page 9 comprises features A to E